

Remarks

This Application has been carefully reviewed in light of the Office Action mailed September 3, 2004. Applicant appreciates the Examiner's consideration of this Application. In order to expedite issuance of a patent from this Application, Applicant has made clarifying amendments to Claims 1-20. These amendments are not considered necessary for patentability. At least the amendments to Claim 20 are not narrowing. Applicant respectfully requests reconsideration and favorable action in this case.

Section 102 Rejections

The Examiner rejects Claims 1-4, 7-15, and 18-19 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,033,139 to Dutcher ("*Dutcher*"). Applicant respectfully disagrees.

Dutcher fails to disclose, teach, or suggest at least the following limitations recited in independent Claim 1, as amended:

- ***an elongated handle extending from the base in a first direction; and***
- ***a plurality of cosmetic skin coloring elements configured to couple to the base and extend therefrom in a second direction substantially perpendicular to the first direction, each cosmetic skin coloring element comprising a cosmetic skin coloring agent disposed proximate a free end thereof, the cosmetic skin coloring agents adapted to cosmetically color a desired area of the skin when directed over the desired area of the skin through movement of the apparatus substantially parallel to the skin.***

The limitations distinguishing independent Claim 1 from *Dutcher* are structural. For example, the recited "elongated handle" and its spatial relationship to the recited "cosmetic" skin coloring elements provide structural distinctions. As another example, at least because the term "cosmetic" is defined as "A preparation designed to beautify the body by direct application" (noun) and "Serving to beautify the body, especially the face and hair" (adjective) (THE AMERICAN HERITAGE DICTIONARY 313 (3d ed. 1993)), the recited "cosmetic" skin coloring elements each comprising a "cosmetic" skin coloring agent, and associated limitations defining the cosmetic nature of these elements and agents, provide structural distinctions.

Applicant respectfully notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131. As illustrated above, *Dutcher* fails to disclose, either expressly or inherently, each and every limitation recited in Applicant's Claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-4, 7-15, and 18-19.

Section 103 Rejections

The Examiner rejects Claims 5-6 and 16-17 under 35 U.S.C. §103(a) as being unpatentable over *Dutcher*. Applicant respectfully disagrees.

Claims 5-6 and 16-17 depend on independent Claims 1 and 12, respectively, which Applicant has shown to be allowable. Claims 5-6 and 16-17 are allowable for at least this reason.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 5-6 and 16-17.

Acknowledged Allowable Subject Matter

Applicant appreciates the Examiner's acknowledgment that original Claim 20 contains allowable subject matter. Original Claim 20 has been placed in independent form as new Claim 21. Applicant respectfully requests consideration and allowance of new Claim 21.

Conclusions

For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to call the undersigned attorney for Applicant at the Examiner's convenience.

A check for \$106.00 is attached for one additional independent claim over three and one additional claim over twenty total. Applicant believes no other fees are due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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